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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hideki Oba

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04/08/2008

WENDEROTH, LIND & PONACK, L.L.P.

2033 K STREET N. W.

SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

PITRAK, JENNIFER S

ART UNIT

PAPER NUMBER

1635

MAIL DATE

DELIVERY MODE

04/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/589,955	OBA ET AL.	
	Examiner	Art Unit	
	JENNIFER PITRAK	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-4 and 9-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-4, drawn to a DNA or RNA localized in the cytoplasm having the 3'- or 5'-terminus modified with a -PO(OH)-O-CH₂CH₂OCH₂CH₂NH-CO-peptide or -O-CO-NH-CH₂CH₂NHCONH(CH₂)₆HC-CO-NH-peptide, wherein the peptide is SEQ ID NO:1.

Group II, claim(s) 1-4, drawn to a DNA or RNA localized in the cytoplasm having the 3'- or 5'-terminus modified with a -PO(OH)-O-CH₂CH₂OCH₂CH₂NH-CO-peptide or -O-CO-NH-CH₂CH₂NHCONH(CH₂)₆HC-CO-NH-peptide, wherein the peptide is SEQ ID NO:2.

Group III, claim(s) 1-4, drawn to a DNA or RNA localized in the cytoplasm having the 3'- or 5'-terminus modified with a -PO(OH)-O-CH₂CH₂OCH₂CH₂NH-CO-peptide or -O-CO-NH-CH₂CH₂NHCONH(CH₂)₆HC-CO-NH-peptide, wherein the peptide is SEQ ID NO:3.

Group IV, claim(s) 1-4, drawn to a DNA or RNA localized in the cytoplasm having the 3'- or 5'-terminus modified with a -PO(OH)-O-CH₂CH₂OCH₂CH₂NH-CO-peptide or -O-CO-NH-CH₂CH₂NHCONH(CH₂)₆HC-CO-NH-peptide, wherein the peptide is SEQ ID NO:4.

Group V, claim(s) 1-4, drawn to a DNA or RNA localized in the cytoplasm having the 3'- or 5'-terminus modified with a -PO(OH)-O-CH₂CH₂OCH₂CH₂NH-CO-peptide or -O-CO-NH-CH₂CH₂NHCONH(CH₂)₆HC-CO-NH-peptide, wherein the peptide is SEQ ID NO:5.

Group VI, claim(s) 1-4, drawn to a DNA or RNA localized in the cytoplasm having the 3'- or 5'-terminus modified with a -PO(OH)-O-CH₂CH₂OCH₂CH₂NH-CO-peptide or -O-CO-NH-CH₂CH₂NHCONH(CH₂)₆HC-CO-NH-peptide, wherein the peptide is SEQ ID NO:6.

Group VII, claim(s) 1-4, drawn to a DNA or RNA localized in the cytoplasm having the 3'- or 5'-terminus modified with a -PO(OH)-O-CH₂CH₂OCH₂CH₂NH-CO-peptide or -O-CO-NH-CH₂CH₂NHCONH(CH₂)₆HC-CO-NH-peptide, wherein the peptide is SEQ ID NO:7.

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Group VIII, claim(s) 1-4, drawn to a DNA or RNA localized in the cytoplasm having the 3'- or 5'-terminus modified with a -PO(OH)-O-CH₂CH₂OCH₂CH₂NH-CO-peptide or -O-CO-NH-CH₂CH₂NHCONH(CH₂)₆HC-CO-NH-peptide, wherein the peptide is SEQ ID NO:8.

Group IX, claim(s) 1-4, drawn to a DNA or RNA localized in the cytoplasm having the 3'- or 5'-terminus modified with a -PO(OH)-O-CH₂CH₂OCH₂CH₂NH-CO-peptide or -O-CO-NH-CH₂CH₂NHCONH(CH₂)₆HC-CO-NH-peptide, wherein the peptide is SEQ ID NO:14.

Group X, claim(s) 1-4, drawn to a DNA or RNA localized in the cytoplasm having the 3'- or 5'-terminus modified with a -PO(OH)-O-CH₂CH₂OCH₂CH₂NH-CO-peptide or -O-CO-NH-CH₂CH₂NHCONH(CH₂)₆HC-CO-NH-peptide, wherein the peptide is SEQ ID NO:15.

Group XI, claim(s) 9-16, drawn to a modified siRNA molecule.

The inventions listed as Groups I-XI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

37 CFR 1.475(b) states:

“An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said

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product, and an apparatus or means specifically designed for carrying out the said process.

37 CFR 1.475(c) states:

“If an application contains claims to more or less than one of the combination of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.”

37 CFR 1.475(d) also states:

“If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and 1.476(c).”

37 CFR 1.475(e) further states:

“The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternative within a single claim.”

In view of 37 CFR 1.475 (b), 37 CFR 1.475 (c), 37 CFR 1.475 (d), and 37 CFR 1.475 (e), Group I is considered the main invention to the product first mentioned in the claims.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Closing

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER PITRAK whose telephone number is (571)270-3061. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Schultz can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jennifer Pitrak, PhD

Examiner

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/Tracy Vivlemore/

Examiner, Art Unit 1635